

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number:

02243-039001

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Application Number

10/721,241

Filed

November 26, 2003

Firm Named Inventor

Stephen C. Olson

Date of Deposit

Art Unit

3725

Examiner

Jason Y. Pahng

Signature

Typed or Printed Name of Person Signing Certificate

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record 03,881

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Registration number if acting under 37 CFR 1.34

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April 9, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representatives are required. Submit multiple forms if more than one signature is required. See below.

☒ Total of 5 pages are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Stephen C. Olson	Art Unit :	3725
Serial No. :	10/721,241	Examiner :	Jason Y. Pahng
Filed :	November 26, 2003	Conf. No. :	6105
Title :	FLUID ENERGY MILL		

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to United States Patent and Trademark Office OG Notices: 12 July 2005, New Pre-Appeal Brief Conference Pilot Program, a request for a review of identified matters on appeal is hereby submitted with the Notice of Appeal. Review of these identified matters by a panel of Examiners is requested because the rejections of record are not proper and are without basis, in view of a clear legal or factual deficiency in the rejections. Applicant reserves all rights to address these and additional matters on appeal in any subsequent appeal brief.

Claims 16-18, 20-29, 50-74 are pending in the application with claims 16 and 55 being independent. Claims 16, 18, 20, 21, 25-27, and 29 stand rejected as being obvious over Trost (U.S. Patent No. 3,229,918) in view of Fay (U.S. Patent No. 3,559,895). Claims 17 and 18, which depend either directly or indirectly from claim 16, stand rejected as being obvious over Trost in view of Fay and further in view of Coombe (U.S. Patent No. 3,840,188). Claims 22-24 and 50-54, which depend either directly or indirectly from claim 16, stand rejected as being obvious over Trost in view of Trost (U.S. Patent No. 2,704,635) ("TrostII") and Fay. Claim 28, which depends from claim 16, has been rejected as being obvious over Trost in view of Fay and in view of Andrews (U.S. Patent No. 2,032,827).

Applicant respectfully disagrees with, and hereby asks the panel to review and reverse, these rejections for at least the following reasons.

Rejection of claims 16, 18, 20, 21, 25-27, and 29

The Examiner, in support of the rejection of claims 16, 18, 20, 21, 25-27, and 29 as obvious over Trost in view of Fay, states "[w]hile Trost does not specifically recite that Trost's grinding chamber is operable to impart particle-on-particle size reduction of material in the chamber, in a closely related art, Fay teaches that such a chamber may be used for reduction of material both by colliding of the particles and by abrading contact with the internal wall. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide Trost with a chamber may [sic] be used for reduction of material both by colliding of the particles and by abrading contact with the internal wall, as taught by Fay." January 8, 2007 Office action at 3 (internal citations omitted). In the January 8, 2007 final Office action, the Examiner equates Trost's classification chamber 44 to the claimed cycloid-shaped grinding chamber. See Final Office Action at 2 ("the monolithic manifold (11) including a cycloid-shaped grinding chamber (44) formed in the front face (Figures 1-3)[.]"). However, not only is the classification chamber 44 not part of the body member 11, which the Examiner equates to the claimed monolithic manifold, but Trost's cycloid-shaped classification chamber 44 is not a grinding chamber. Instead, Trost describes the classification chamber 44 as a low velocity chamber permitting smaller particles to be separated (i.e., classified) and to exit through an outlet and larger particles to return to an impact chamber 56 in which the particle-on-particle size reduction actually takes place.

There is no description or suggestion in Fay that would lead one of ordinary skill in the art to modify Trost's classification chamber 44 to provide particle-on-particle size reduction as the Examiner proposes. Such a combination is purely a hindsight reconstruction of Trost's device based on applicant's claims.

Indeed, Trost already includes impact chamber 56 that provides for particle size reduction, and there is nothing in Fay to suggest that any benefit could be obtained by modifying Trost's classification chamber 44 to form a second grinding chamber as the Examiner suggests. It would also seem that modifying Trost's classification chamber 44 to provide abrading contact between the particles and the internal wall of the chamber, as Fay describes, would have the

disadvantage of introducing mechanical abrasion of the wall liners (e.g., liner 34), which is of concern to Trost (see, e.g., col. 1, lines 24-27; col. 5, lines 21-22), and further, since Trost's classification chamber 44 only includes an entrance and exit, for the classification chamber 44 to achieve any suitable form of grinding would require that the exit be closed off to provide for the requisite recirculation of the particles within the chamber 44. Trost does not disclose or suggest such a modification, and nothing in Fay suggests modifying Trost's chamber in such a manner. Accordingly, one of ordinary skill in the art would not have been motivated to combine the teachings of Trost and Fay to arrive at applicant's claimed invention.

The Advisory Action asserts that applicant's arguments concerning the lack of motivation to modify Trost's classification chamber 44 in the manner suggested by the Examiner is "not relevant because no such claim rejection has been made. There is no mention of element (44) in pages 2 and 3 of the Office action dated January 8, 2007." Advisory Action, Continuation Sheet. However, applicant respectfully notes that the quotation at page 2 from the January 8, 2007 final office action discussed above, clearly shows that the Examiner relies upon the "cycloid-shaped grinding chamber (44)" as the claimed grinding chamber. Accordingly, applicant's arguments are indeed relevant and the Examiner's rejection of those arguments are clear error that the panel should reverse.

Because it would not have been obvious to modify Trost with the teachings of Fay, applicant respectfully requests reversal of the rejections of claims 16, 18, 20, 21, 25-27, and 29.

Rejection of dependent claims 17, 18, 22-24, 28, and 50-54

Applicant addressed the rejections of dependent claims 17, 18, 22-24, 28, and 50-54 in its March 7, 2007 Amendment in Reply to Action of January 8, 2007 ("March 7, 2007 Amendment"). For at least the reasons set forth in its March 7, 2007 Amendment at pages 10 and 11, applicant respectfully requests that the panel review and reverse these rejections.

Please apply any charges or credits to Deposit Account 06-1050.

Respectfully submitted,

Date: April 9, 2007

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